

Remarks

Reconsideration and further examination is respectfully requested. Claims 1-11 were last presented for examination. Claims 1-11 are rejected. Claims 1-11 are submitted for further examination.

The Examiner provisionally rejected all of the claims based on statutory double patenting as claiming the same invention as copending Application No. 09/264,286.

The Examiner's attention is drawn to the fact that all of the claims of Application No. 09/264,286 are method claims while all of the claims in the present Application are apparatus claims. Applicant believes that a judicially-created double patenting rejection is more appropriate based on the clear differences in the claims and offers to submit a terminal disclaimer under 37 CFR 1.321(c) should the Examiner issue an obviousness-type double patenting rejection.

The law of double patenting is succinctly set forth in In Re Vogle, 164 USPQ 619 (CCPA 1970). As enunciated by the Court, a double patenting rejection prevents two patents for issuing on the "same matter". The Court uses the example of a claim that recites "halogen" as not being drawn to the same invention as a claim reciting "chlorine". The Court goes further to define the test for "same invention" as "whether one of the claims could be literally infringed without literally infringing the other". See In Re Vogel at 622. Similarly, in In Re Eckel, 157 USPQ 415 (CCPA 1968), the CCPA held the same invention means "identically" the same invention.

In Re Boyland, 55 CCPA 1041, 392 F.2nd 1017, 157 USPQ 370 (1968), states that 35 USC 101 prevents two patents from issuing on the same invention. The term "invention" here means "what is defined by the claims, whether new or old, obvious or non-obvious." In so stating, the Court recognized that all of the recitations in the claim must be considered and not just that feature of the claim which is considered to render it patentable. Thus, in comparing two claims to determine whether they both claim the

“same invention,” it is improper to compare the “inventive feature” or “gist” of one claim with the “inventive feature,” etc., of another claim, without comparing all of the recitations in both claims. As stated in Vogel, by “same invention,” we mean identical subject matter. Again, the only objective test for determining the same invention is whether one of the claims could be literally infringed without literally infringing the claims of the other. The court stated that if this is not the case, the claims do not define identically the same invention.

The Court also noted in Vogel that when the claims of the application define a merely obvious variation of the invention disclosed and claimed in the patent, that an obvious double patenting rejection could be applied. This is not a rejection based on prior art, but constitutes a rejection under 35 USC 101. See In Re Boyland supra and In Re Aldrich, 55 CCPA 1431, 398 Fed.2nd 855, 158 USPQ 311 (1968). Determination of what constitutes an obvious variation must be derived from the claimed invention in both the parent and child application. In this regard, the claims of both the parent and child application are interpreted in light of the specific embodiment disclosed in each of these documents. The test for obviousness is analogous to the test for obviousness under 35 USC 103, even though the rejection is not made under that section. See In Re Braithwaite, 154 USPQ 29 (CCPA 1967). The same type of evidence which is used to rebut a Section 103 rejection may be used to rebut an obvious type double patenting rejection.

Terminal disclaimers to overcome obviousness-type double patenting rejections are clearly permitted in 35 USC 253. Furthermore, 37 CFR 1.321 specifically allows for the filing of the terminal disclaimer to overcome obviousness-type double patenting rejections. As set forth in 37 CFR 1.321(b), the terminal disclaimer must include a provision that any patent granted on the application shall be enforceable only for and during such period as the patent is commonly owned with the application or patent which formed the basis of the rejection.

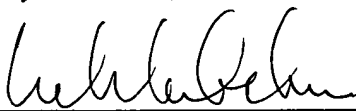
Referring to the present application, all of the claims are apparatus claims whereas all of the claims of Application No. 09/264,286 are all method claims. Clearly, from the examples cited above, apparatus and method claims may be considered for an obviousness-type double patenting but not for statutory double patenting. Either set of claims could be infringed without infringing the other. Applicant requests the statutory double patenting rejection be removed on this basis.

As stated above, Applicant is prepared to enter a terminal disclaimer under 37 CFR 1.321(c) should the Examiner issue an obviousness-type double patenting rejection.

For these reasons this application is now considered to be in condition for allowance and such action is earnestly solicited.

Dated this 27th day of May, 2003.

Respectfully submitted,

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